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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,627	10/02/2000	Frank D'Aguanno	18574.00201	4728

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EXAMINER

WATSON, ROBERT C

ART UNIT	PAPER NUMBER
3723	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/676,627

Applicant(s)

D'AGUANNO, FRANK

Examiner

Robert C. Watson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1,2 and 16-23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-15 and 30 is/are allowed.
- 6) ☒ Claim(s) 24-29 and 31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/23/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Applicant states that newly added claims 17, 18, 22, and 23 read on the elected apparatus. However, the structure recited in these claims does not appear to read on the structure shown in Figures 1-10. The specification does not appear to provide support for the structure recited in these new claims. Moreover, the structure recited in these new claims may be new matter. The structure recited in these claims appears to be a different distinct apparatus species than that which has been originally presented. Accordingly, newly presented claims 17, 18, 22, and 23 are withdrawn from further consideration based on the original presentation of claims.

Claims 29 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 29, lines 2-3 the phrase, "a pin engaged in said slot" is not understood and no explanation of this structure can be found in the disclosure. In claim 31, line 11 "rotatable member said resilient spring" appears to be an incomplete phrase and cannot be understood.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Machado et al.

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Machado et al shows a separation apparatus for separating a club head from a club shaft. In Machado et al, Figure 1, 48 is a movable gripping member for engaging and holding the club shaft at a first position. Element 46 is a separation member mounted on the base 16 for movement parallel to the longitudinal axis of the club shaft. The separation member engages the club head and further includes a U-shaped element 42 which is deemed to be an engaging portion for engaging the club shaft in a closely interfitting manner at a second position and during translation. Figure 1 illustrates the U-shaped element engaging the club shaft. Although the description does not specifically state that the U-shaped portion engages the club shaft it is considered inherent in the Machado et al device that the U-shaped element engages the club shaft.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machado et al.

Machado et al shows a separation apparatus for separating a club head from a club shaft. In Machado et al, Figure 1, 48 is a movable gripping member for engaging and holding the club shaft at a first position. Element 46 is a separation member mounted on the base 16 for movement parallel to the longitudinal axis of the club shaft. The separation member engages the club head and further includes a U-shaped

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element 42 which is deemed to be an engaging portion for engaging the club shaft. It is would have been obvious for one of ordinary skill in the art to size and shape the U-shaped element 42 in a closely interfitting manner with respect to the club shaft. One of ordinary skill in the art would have been motivated to do this in order to adequately support the club shaft prior, during, and after the club head removal.

Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machado et al in view of Marshall.

Machado et al shows a separation apparatus for separating a club head from a club shaft wherein the forcing mechanism is a screw member.

Marshall teaches that a separation apparatus for separating a club head from a club shaft may be a pneumatic cylinder and piston. See in particular, Marshall, column 2, lines 38-39.

To substitute a pneumatic cylinder and piston for the screw member in Machado et al would have been obvious at the time of the invention in view of the disclosure of Marshall. One of ordinary skill in the art would have been motivated to do this in order to reduce the manual effort required to separate the club head from the club shaft.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Machado et al in view of Milam.

Machado et al shows a separation apparatus for separating a club head from a club shaft wherein the plate 48 of the gripping member is not directly coupled to the threaded rod.

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Milam teaches a separation apparatus for separating a club head from a club shaft wherein the plate 27 of the gripping member is directly coupled to the threaded rod 35.

To directly couple the threaded rod to the plate in Machado et al would have been obvious at the time of the invention in view of the disclosure of Milam. One of ordinary skill in the art would have been motivated to do this in order to provide a more positive and controlled movement of the gripping member.

Claims 3-15 and 30 are allowed.

Claims 1-2 and 16-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 12.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert C. Watson whose telephone number is 703 308-1747. The examiner can normally be reached on Mon. - Thurs. , 5:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail III can be reached on 703 308-2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

rcw

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